

REMARKS

The title of the invention has been changed as requested.

Claims 1, 3 and 4 are rejected under 35 U.S.C. §102(b) as being anticipated by *Sainsbury et al.* (U.S. 6,104,162). Applicants traverse this rejection on the grounds that this reference is defective in supporting a rejection under 35 U.S.C. §102.

Independent Claims 1, 12 and 23 include: ... wherein the predefined range includes a minimum value slightly above 100% of the target voltage and a maximum value slightly below 125% of the target voltage.

Claims 7 and 18 are indicated as allowed. Claims 1, 12 and 23 include the subject matter of claims 7 and 18, therefore claims 1, 12 and 23 are submitted to be allowable. Claims 7 and 18 are cancelled.

The PTO provides in MPEP §2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection *Sainsbury et al.* reference must contain all of the claimed elements of independent claims 1, 12 and 23. However, the invention as claimed, is not shown or taught in this reference. Therefore, the rejection is unsupported by the art and should be withdrawn.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." "The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Therefore, independent claims 1, 12 and 23 and claims dependent therefrom are not anticipated by the cited art and are therefore submitted to be allowable.

Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Sainsbury et al.* as applied to claim 1 above, and further in view of *Wilcox et al.* (U.S. 5,994,885). Claims 5, 6, and 8-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Sainsbury et al.* as applied to claim 1 above, and further in view of *Shyr et al.* (U.S. 5,903,764). Claims 12, 14 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Sainsbury et al.* in view of *Hatular* (U.S. 6,184,660). Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Sainsbury et al.* in view of *Hatular* as applied to claim 12 above, and further in view of *Wilcox et al.* Claims 16, 17, 19 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Sainsbury et al.* in view of *Hatular* as applied to claim 12 above, and further in view of *Shyr et al.* Claim 21 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Sainsbury et al.* in view of *Hatular* as applied to claim 12 above, and further in view of *Shyr et al.* Claim 22 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Sainsbury et al.* in view of *Hatular*. Applicants traverse these rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

Independent claims 1 and 12 include: ...wherein the predefined range includes a minimum value slightly above 100% of the target voltage and a maximum value slightly below 125% of the target voltage.

Claims 2-6, 8-11, 13-17 and 19-21 depend from either claim 1 or claim 12, therefore these dependent claims are allowable for at least these reasons.

Claim 22 includes: ... a controller module operable to receive a first feedback signal input indicative of a target voltage required by the processor and a second

feedback signal input indicative of the second DC output, the target voltage being transferred to an AC-DC adapter as an external feedback signal, the controller adjusting the control signal responsive to the first and second feedback signal inputs, the adjusting of the control signal causing the buck converter module to maintain the second DC output to be within a predefined range of the target voltage, the second DC output being measured instantly prior to a loss of the external feedback signal.

As the PTO recognizes in MPEP § 2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness.....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

The combined references fail to teach or suggest the claimed combination.

Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection because neither of the references teach or even suggest the desirability of the combination. Moreover, neither of the references provide any incentive or motivation in supporting the desirability of the combination.

The MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO "failed to establish a *prima facie* case of obviousness":

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).


More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had "reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious." The court noted that to "prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness." The court further noted that there

were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Here, according to the court, the board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: "If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance."

Therefore, independent claims 1, 12, 22 and 23 and the claims dependent therefrom are submitted to be allowable.


In view of the above, it is respectfully submitted that claims 1-6, 8-17 and 19-23 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,


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